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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,751	01/04/2006	Kazuhiro Ikeda	265257US8PCT	9312
22850 7590 08/27/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KIM, ELLEN E	
			ART UNIT 2874	PAPER NUMBER
			NOTIFICATION DATE 08/27/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/522,751	IKEDA, KAZUHIRO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ellen Kim	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 10 and 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/25/05, 8/1/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is responsive to Applicant's election of specie filed on 6/4/07.

#### ***Election/Restrictions***

Claims 1-8, 10, and 12-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected embodiments, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/4/07. Applicant traversed the restriction because Examiner fails to establish undue burden if non-elected claims are examine. Examiner does not agree with Applicant's argument because non-elected species clearly require further consideration and search.

Claims 9 and 11 are examined.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phua et al [USPAT 7,003,183].**

Phua et al disclose a polarization mode dispersion compensator for compensating for polarization mode dispersion that occurs in an optical signal propagating along a transmission line, comprising:

- a first polarization controller 202 [fig. 15] for performing polarization conversion on the optical signal input via the transmission line;
- a first fixed PMD emulator 310, 320, 330, 340 [see column 12, line57-column13, line 15] for adding only a fixed first-order PMD to the optical signal which is polarization-converted by said first polarization controller 202;
- a second polarization controller 375 [fig. 15] for performing polarization conversion on the optical signal input via the transmission line;
- a second fixed PMD emulator 360, 370, 380, 390 [see column 12, line57-column13, line 15] for adding only a fixed first-order PMD to the optical signal which is polarization-converted by said second polarization controller 375; and
- monitoring means 212 for monitoring a state of the optical signal output from said second fixed PMD emulator.

Fig. 15 of Phua et al disclose every aspect of claimed invention except for the controlling means for controlling said first polarization controller and said second polarization controller based on a feedback signal from said monitoring means.

Phua et al however show in fig. 16 the controlling means for controlling said first polarization controller and said second polarization controller.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the embodiment of fig. 15 of Phua et al device to include the controlling means for controlling said first polarization controller and said second polarization controller based on a feedback signal from said monitoring means as shown in the embodiment of fig. 16 of Phua et al for the purpose of better controlling of the polarization of the device.

In re claim 11, Phua et al show said second fixed PMD emulator is configured by three or more polarization maintaining fibers.

### ***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

For all official patent application related correspondence for organizations reporting to the Commissioner of Patents:

- Correspondence that is transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Further references of interest are cited on Form PLO-892, which is attachment to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen Kim whose telephone number is (571) 272-2349. The examiner can normally be reached on Monday through Thursday.



Ellen E. Kim

Primary Examiner

August 18, 2007/EK